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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,100	08/31/2001	Christopher E. McConn	086055-0103	3138

25734 7590 03/22/2005

FOLEY & LARDNER  
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SAN FRANCISCO, CA 94111

EXAMINER
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GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,100

Applicant(s)

MCCONN ET AL.

Examiner

Gabriel I Garcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/10/01.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Part III DETAILED ACTION

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al. (6,324,521).

With regard to claim 1, Shiota et al. teaches A method for enabling a plurality of photolabs (2,3, or 4) to provide digital image processing services to customers (figs. Items labeled 1), comprising: receiving website feature-set data from at least one photolab (see figs. 2-8, and col. 8, lines 17-30 and col. 10, line 59 thru col. 11, line 21); storing the feature-set data for the at least one photolab in a database (e.g. figs. 6-7, and col. 3, line 62 thru col. 4, line 42, col. 2, lines 21-32, and col.

10, line 59 thru col. 11, line 21); processing the feature-set data for the at least one photolab in order to create a customized website for said photolab (e.g. col. 4, line 42, col. 2, lines 21-32, and col. 10, line 59 thru col. 11, line 21) ; and providing the at least one photolab and its customers with access to the customized website (e.g. col. 4, line 42, col. 2, lines 21-32, and col. 10, line 59 thru col. 11, line 21).

With regard to claims 2-4, Shiota et al. teaches which a customized website includes the display of the at least one photolab's branding including at least one trademark or service mark (inherently reads on col. 4, lines 42-64 and col. 10, line 59 thru col.11, line 53, e.g. the company's name can be display in the order information as the trademark, branding or service mark of the photolab).

With regard to claims 5-6, Shiota et al. teaches receiving digital images from at least one photolab (see figs. 1-8); associating the digital images to at least one customer of said at least one photolab (see figs. 2-4); storing the digital images, as associated to said at least one customer, in a file server (see figs. 3-8, and col. 4, line 42, col. 2, lines 21-32, and col. 10, line 59 thru col. 11, line 21); and prompting the at least one customer to use the at least one photolab's customized website to view and order the customer's digital

images (see figs 1-8 and (see figs. 3-8, and col. 4, line 42, col. 2, lines 21-32, and col. 10, line 59 thru col. 11, line 21)).

**Conclusion**

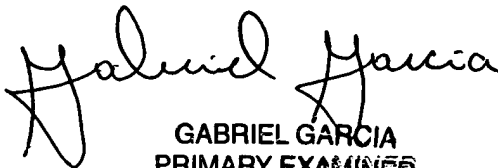
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chui et al. (6,657,702) teaches a method facilitating photographic print re-ordering.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Gabriel I. Garcia  
Primary Examiner  
March 2, 2005

  
GABRIEL GARCIA  
PRIMARY EXAMINER